

REMARKS

This communication is filed in response to the Office Action mailed on November 4, 2004. No claims are amended, no claims are canceled, and no claims have been added. As a result, claims 1-65 remain pending in this application, of which claims 5-19, 21-27, 31-33, 39-43, and 49-64 are withdrawn. If the Examiner is not convinced that the pending claims are in condition for allowance after reviewing this document, the courtesy of an Examiner's Interview is respectfully requested prior to preparing and mailing any Final Office Action.

§102 Rejection of the Claims

Claims 1-4, 20, 28, 38, 43, and 65 were rejected under 35 USC § 102(b) as being anticipated by Kumagai et al. (U.S. Patent No. 6,147,573, hereinafter "Kumagai"). First, the Applicant does not admit that Kumagai is prior art, and reserves the right to swear behind this reference in the future. Second, because Kumagai does not disclose the identical invention as claimed, the Applicant respectfully traverses this rejection.

Kumagai teaches a multilayer electronic body 24 to be mounted to a printed circuit board 9. See Kumagai, FIG. 1D and Col. 4, lines 5-7. The multilayer electronic body 24 is made from coil conductors 2 formed on green sheets 1 and connected to each other using through-holes 3. See Kumagai, FIG. 1A and Col. 4, lines 13-21. It is asserted in the Office Action that Kumagai's conductors 29 (see FIGs. 1B and 1C) are the same as the interstices 150, 160 (See Application, FIG. 4A) claimed by the Applicant in claims 1, 20, 28, 38, and 65. However, such is not the case.

Independent claims 1 and 20 include the following limitation: "a second conductive layer including a second interstice engaged with the first interstice". Thus the first and second interstices are *engaged* (see Figure 4A, elements 150, 160). To be "engaged" means "meshed," which in turn, means "interlocked." *See Webster's Ninth New Collegiate Dictionary*, G. & C. Merriam Company, pgs. 412 and 744, 1983. In other words, if one were to attempt to "pull" the conductive layers 110, 120 apart in the $\pm Y$ direction in Figure 4A, for example, the engaged interstices 150, 160 would prevent such separation. However, this cannot be said about the

conductors 29 of Kumagai. These conductors 29, which serve to connect the coil ends 40 with electrodes 20, are not engaged. See Kumagai, Col. 4, lines 50-55, and FIGs. 1B, 1C.

Independent claims 28 and 38 include the limitations “a first interstice . . . engaged with a second interstice” and “a second interstice engaged with the first interstice,” respectively. Dependent claims 2-4 and 43 also include the limitation of engaged interstices. Finally, independent claim 65 includes the limitation “means for engaging the first and second interstices.”

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added). Since Kumagai does not teach interstices that engage, what is disclosed by Kumagai is not identical to the subject matter of the embodiments claimed, and thus, the rejection of claims 1-4, 20, 28, 38, 43, and 65 under § 102 is improper. Reconsideration and allowance are respectfully requested.

§103 Rejection of the Claims

Claims 29-30 were rejected under 35 USC § 103(a) as being unpatentable over Kumagai in view of Takaya et al. (U.S. Patent No. 6,713,162, hereinafter “Takaya”). Claims 34-37 and 44 were rejected under 35 USC § 103(a) as being unpatentable over Kumagai in view of Lee et al. (U.S. Patent No. 5,497,037, hereinafter “Lee”). Claims 45-48 were rejected under 35 USC § 103(a) as being unpatentable over Kumagai in view of Takeshita et al. (U.S. Patent No. 6,469,259, hereinafter “Takeshita”). First, the Applicant does not admit that Takaya, Lee, or Takeshita are prior art and reserves the right to swear behind these references in the future.

Second, since a *prima facie* case of obviousness has not been established, as required by M.P.E.P. § 2142, the Applicant respectfully traverses these rejections.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which indicates that the motivation must be supported by evidence in the record.

No proper *prima facie* case of obviousness has been established because none of the required elements has been demonstrated, that is: (1) combining the references does not teach all of the limitations set forth in the claims, (2) there is no motivation to combine the references, and (3) combining the references provides no reasonable expectation of success. Each of these points will be explained in detail, as follows.

The References Do Not Contain All Limitations: First, with respect to independent claims 28, 34, and 44-46, it has been demonstrated above that Kumagai does not teach *engaged* interstices. Neither does Takaya, Lee, or Takeshita.

Therefore, no combination of Kumagai and Takaya (or Lee or Takeshita) can provide the engaging interstices claimed by the Applicant in independent claims 28, 34, and 44-46, and a *prima facie* case of obviousness has not been established. It is respectfully noted that if an independent claim is nonobvious under 35 USC § 103, then any claim depending therefrom is

also nonobvious. See M.P.E.P. § 2143.03. Therefore all of the rejected dependent claims (i.e., claims 29-30, 35-37, and 47-48) are also nonobvious.

No Motivation to Combine the References: Kumagai teaches away from combination with Takaya, since Kumagai's preference is that "[t]he green sheets 1 are preferably made of material ... obtaining a reduced distributed capacitance suitable for high-frequency use." See Kumagai, Col. 4, lines 23-26. This information, taken directly from Kumagai, contradicts the assertion made in the Office Action, viz "it would have been obvious ...to use a dielectric layer ... as taught by Kumagai ... for the purpose of ... increasing charge storage in the dielectric layer." One of skill in the art would not be motivated to combine these references, since increased capacitance is not a desired result. Thus, the Examiner appears to be using personal knowledge, and is therefore respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Similar difficulties exist with the proposed combination of Kumagai and Lee, or Kumagai and Takeshita. For example, while the assertion is made that it "would have been obvious to ... employ a circuit connected to a power supply as taught by Lee, applied in the circuit board of Kumagai for the purpose of providing DC and AC power supply voltages" and to "utilize two power supplies in the system of Kumagai et al., as taught by Lee et al. ... for the purpose of providing DC/DC or DC/AC voltage power", no such needs are expressed by Kumagai. In fact, the Applicant was unable to find a single instance of the any of the terms "power", "supply", or "voltage" anywhere within the bounds of Kumagai.

The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); and M.P.E.P. § 2143.01. Thus, these assertions are not in accordance with the requirements of *In re Sang Su Lee*, and the Examiner again appears to be using personal knowledge. It is therefore respectfully requested that the Examiner submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Finally, it is clear that Takeshita also teaches away from combination with Kumagai by disclaiming Kumagai's approach of using individual filter component bodies 24. Takeshita notes that "... the above method of using the decoupling capacitor can trap only the high frequency current at a particular frequency that is determined by the capacity and parasitic

inductance of the decoupling capacitor, and has an adverse affect that another noise-causing high-frequency current is produced at other frequencies.” See Takeshita at Col. 1, lines 52-57. This statement directly contradicts the assertion made in the Office Action, that “it would have been obvious … to employ a memory chip or a processor in the memory circuit module or computer system of Kumagai et al. as taught by Takeshita et al. for the purpose of providing high frequency current.” Thus, this assertion is also not in accordance with the requirements of *In re Sang Su Lee*, and the Examiner appears to be using personal knowledge. It is therefore again respectfully requested that the Examiner submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

No Reasonable Expectation of Success: Adding the capacitors of Takaya (or the power supplies of Lee, or the circuit elements of Takeshita) to the multilayer bodies 24 of Kumagai does nothing to provide the engaged interstices claimed by the Applicant. This is because none of the references teaches the engaging structures described, illustrated, and claimed by the Applicant.

With respect to the combinations suggested in the Office Action, it is respectfully noted that the test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). References must be considered in their entirety, including parts that teach away from the claims. See MPEP § 2141.02.

In summary, none of the cited references teach the engagement of interstices as claimed by the Applicant in independent claims 1, 20, 28, 34, 38, and 44-46. No evidence has been entered in the record to support a need to combine the references (in fact the references teach away from such combination), and no reasonable expectation of success results from any combination. The requirements of M.P.E.P. § 2142 have not been satisfied, and a *prima facie* case of obviousness has not been established with respect to these independent claims. All rejected dependent claims are also nonobvious, since claims depending from nonobvious independent claims are also nonobvious. It is therefore respectfully requested that the rejections of claims 29-30, 34-37, and 44-48 under 35 U.S.C. § 103 be reconsidered and withdrawn.

CONCLUSION

The Applicant respectfully submits that all of the pending claims are in condition for allowance and notification to that effect is earnestly requested. As noted above, if the Examiner is not convinced that all of the pending claims are in condition for allowance after reviewing this document, the courtesy of an Examiner's Interview is respectfully requested prior to preparing and mailing any Final Office Action.

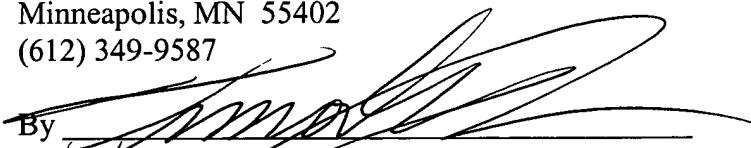
The Examiner is invited to telephone the Applicant's attorney Mark Muller at (210) 308-5677, or the undersigned attorney to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 4 day of February, 2005.

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ZLL